

REMARKS

Claims 1-3 and 5-17 are pending and stand ready for further action on the merits. Support for the amendment to claim 1 can be found in cancelled claim 4 and in the description on page 26, lines 11-12 of the present specification. No new matter has been added by way of the above-amendment.

Issues Under 35 U.S.C. §112

Claims 1-17 are rejected under 35 U.S.C. §112, first and second paragraphs.

Applicants respectfully traverse each of the rejections.

Specifically, the Examiner is objecting to the amendment to claim 1, which recites an "emulsion layer" (see line 7). The Examiner finds that there is insufficient written description support in the specification for this term such that the recitation of this term adds "new matter" to the disclosure. Also, the Examiner finds that the present specification does not describe the metes and bounds of this term rendering this term indefinite.

In response, Applicants respectfully submit that there is sufficient description in the specification of an "emulsion layer." The Examiner's attention is directed to the disclosure from page 150, line 11 to page 154, line 14 and at page 163, line 21. Specifically, the "emulsion layer" of claim 1 is defined as being the layer in which the silver halide emulsion is formed. At page

163, line 21, the specification indicates that the "emulsion layer" is an image forming layer. Also, the preparatory method for obtaining the silver halide emulsion is described at page 150, line 11 to page 154, line 14.

Accordingly, the present inventors were in possession of the heat-developable image recording material comprising a binder in an "emulsion layer" as defined in present claim 1, at the instant priority date. As such, withdrawal of the rejection under 35 U.S.C. §112, first paragraph is respectfully requested.

Also, the metes and bounds of the "emulsion layer" of claim 1 is sufficiently set forth to satisfy the requirements of 35 U.S.C. §112, second paragraph. As such, withdrawal of the rejection under 35 U.S.C. §112, second paragraph is respectfully requested.

Issues Under 35 U.S.C. §102 and §103

The following rejections are pending:

- (1) claims 1-6 are rejected under 35 USC 102(b) or under 35 USC 103(a) as being unpatentable over European Patent 0911691 A1 (EP '691); and
- (2) claims 7-17 are rejected under 35 USC 103(a) as being unpatentable over EP '691, Kato, Harring et al. - USP 5,637,449 and EP '764.

Applicants respectfully traverse each of the rejections.

The Examiner indicates that the outstanding issue with respect to the patentability of the present invention over the cited prior art is whether the latex taught in EP '691 contains halide ions in a concentration such that the halogen ion content of not more than 100 ppm, as presently claimed. The Examiner has taken the position that the latex taught in EP '691 would inherently have a halogen ion content of not more than 100 ppm as presently claimed, since the goal of EP '691 is to reduce the "ionic conductivity" of the polymer latex. EP '691 teaches that the ionic conductivity of the polymer latex is from 0.05 to 2.5 mS/cm. In order to obtain this reduced ionic conductivity, EP '691 purifies the latex with dialysis ion exchange resin or ultra filtration.

In order to further distinguish the present invention from EP '691, Applicants have amended claim 1 to recite that the polymer latex is "not subjected to purification through a desalting step." As noted in the first paragraph on page 26 of the present specification, the "desalting step" is defined to include purification with a dialysis membrane and purification with an ion exchange resin. Accordingly, the inventive claims do not include a polymer latex which has been purified with a

dialysis membrane or with an ion exchange resin as is required by EP '691.

As noted in the second full paragraph on page 4 of the present specification, JP-A-11-129629 (a patent in the same patent family as EP '691), the present inventors have found that the purification of latex with a dialysis membrane has a deleterious effect on the latex. This method disadvantageously tends to be accompanied with degradation of the coating property owing to the aggregation of latex as the latex is purified. In Applicants' May 2, 2003 Amendment, Applicants argued that the method of purification is important. Specifically, Applicants argued as follows:

As noted therein, EP '691 (and JP '629) use dialysis to purify the latex. The present inventors have found that the method of purifying a latex using a dialysis membrane, has the disadvantage of degrading the coating property due to the aggregation of latex. This deleterious effect can be seen in the experiments described in the present specification. The following table contains data which correspond to the data of Table 1 found on page 174 of the present specification.

Sample No	Binder for Image Forming Layer		Coating Property	Image Preservability
	Species	Halogen Ion Content (ppm)		
102	RP-1	1,000	B	0.144
103	RP-2	550	C	0.033

As described in the first paragraph on page 172, the difference between samples 102 and 103 is that sample 103

was prepared by purifying the latex of sample 102 using dialysis. Accordingly, there is a marked reduction in the halogen ion content which results in improved image preservability of the heat-developable image recording material. However, the coating property is disadvantageously reduced.

The advantage of the present invention is that the image preservability of the heat-developable image recording material is improved without a concurrent reduction in the coating property. This combination of properties is neither taught nor suggested by the prior art.

In response to the above-arguments, the Examiner has maintained the rejection based on the following position:

the statement of the improvement of the image preservability and the coating property is based on the counsel's assertion. Counsel's arguments cannot take the place of evidence. In *re Greenfield*, 571 F.2d 1185, 197 USPQ 227 (CCPA 1978).

In response, Applicants respectfully submit that there is no requirement that the assertion of unexpected results be made by a skilled artisan, when the evidence in the specification is of such a nature that the skilled artisan would reach this conclusion. Support for this position can be found in *In re Soni*, 34 USPQ2d 1684 (C.A.Fed. 1995). In *Soni*, the Examiner maintained an obviousness rejection without considering the evidence of unexpected results in the specification in spite of Applicants' attorney's assertion that the evidence was unexpected based on the cited references. The court stated:

[c]onsistent with the rule that all evidence of nonobviousness must be considered when assessing patentability, the PTO must consider comparative data in the specification in determining whether the claimed invention provides unexpected results. ... Here, Soni's specification contains more than mere argument or conclusory statements; it contains specific data indicating improved properties.

The court went on to emphasize that Soni owed the PTO a duty of candor in filing the application, and as such, the evidence in the specification should be taken into consideration by the Examiner when reviewing prior art references under the obviousness standard.

Accordingly, Applicants respectfully request that the Examiner reviews the evidence in the specification in light of the *Soni*. Applicants respectfully submit that when the Examiner considers the evidence of the specification, the Examiner will find that a skilled artisan would reasonably conclude that the evidence in the specification is unexpected.

Furthermore, the Examiner states on page 6, lines 8-12 of the Office Action as follows:

...these results would have been found expected by the worker of ordinary skill in the art. The applicants are referred to page 28; Table 1 wherein the latex prepared by separation function polymer treatment improves photographic properties such as fog, sensitivity and image stability.

In response, Applicants respectfully submit that the present inventors do not use ultra filtration, ion exchange resin and dialysis for purification of the polymer latex as required by EP

'691. In one embodiment, the present inventors maintain the halogen ion content in the polymer latex to such a low level by controlling the kind and amount of additives used in the preparation of the polymer latex. Particularly, additives which contain a halogen ion are preferably used in a small amount or are used after purification, see page 26, second full paragraph. The record is clear that the use of ultra filtration, ion exchange resin and dialysis for purification of the polymer latex as described in Table 1 on page 28 of EP '691 is inadequate.

First, Applicants have shown that the ultra filtration method is insufficient for reducing the halogen ion content in the polymer latex to below 100 ppm in the Declaration attached to the May 2, 2003 Amendment. Second, the ion exchange method and dialysis method are: a) excluded from the inventive claims; and b) described as resulting in disadvantageous aggregation of the polymer latex by the present inventors at page 26, first full paragraph of the specification. Accordingly, significant patentable distinctions exist between the teachings of EP '691 and the present invention.

The Examiner, aware of the deficiencies of EP '691, cites Kato, Harring et al. and EP '764 in order to cure those deficiencies. Applicants respectfully submit that none of Kato, Harring et al. and EP '764 cure the deficiencies of EP '691, since these secondary references fail to teach or suggest a method of

purifying the polymer latex to have a halogen ion content of not more than 100 ppm without a desalting step, as presently claimed.

As the MPEP directs, all the claim limitations must be taught or suggested by the prior art to establish a *prima facie* case of obviousness. See MPEP §2143.03.

Since the cited references fail to teach or fairly suggest a method of purifying the polymer latex to have a halogen ion content of not more than 100 ppm without a desalting step, a *prima facie* case of obviousness cannot be said to exist. Accordingly, withdrawal of the rejections are respectfully requested.

Conclusion

In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. However, in the event the Examiner finds to the contrary, Applicants respectfully request that this Amendment be entered into the official record for placing the claims in better form for appeal.


If the Examiner has any questions concerning this application, he is requested to contact Garth M. Dahlen, Ph.D. (#43,575) at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees


required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

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Search Results - Record(s) 1 through 9 of 9 returned.☐ 1. Document ID: US 20020146654 A1

L12: Entry 1 of 9

File: PGPB

Oct 10, 2002

PGPUB-DOCUMENT-NUMBER: 20020146654

PGPUB-FILING-TYPE: new

DOCUMENT-IDENTIFIER: US 20020146654 A1

TITLE: Heat-developable image recording material

PUBLICATION-DATE: October 10, 2002

INVENTOR-INFORMATION:

NAME	CITY	STATE	COUNTRY	RULE-47
Tsukada, Yoshihisa	Kanagawa		JP	
Nakagawa, Hajime	Kanagawa		JP	
Yasuda, Tomokazu	Kanagawa		JP	

US-CL-CURRENT: 430/617; 430/350, 430/620, 430/627

Full	Title	Citation	Front	Review	Classification	Date	Reference	Sequences	Attachments	Claims	KWIC	Draw Desc	Image
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☐ 2. Document ID: JP 57206853 A

L12: Entry 2 of 9

File: JPAB

Dec 18, 1982

PUB-NO: JP357206853A

DOCUMENT-IDENTIFIER: JP 57206853 A

TITLE: ELECTRODE FOR DETECTING HALOGEN ION

PUBN-DATE: December 18, 1982

INVENTOR-INFORMATION:

NAME	COUNTRY
SESHIMOTO, OSAMU	
SAKAGUCHI, SHINJI	
TAKAYAMA, TAKESHI	
SATO, AKIRA	

INT-CL (IPC): G01N 27/30; G01N 27/40

Full	Title	Citation	Front	Review	Classification	Date	Reference	Sequences	Attachments	Claims	KWIC	Draw Desc	Clip Img
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☐ 3. Document ID: GB 2105043 A

L12: Entry 3 of 9

File: EPAB

Mar 16, 1983

PUB-NO: GB002105043A

DOCUMENT-IDENTIFIER: GB 2105043 A

TITLE: Halide ion selective electrode

PUBN-DATE: March 16, 1983

INVENTOR-INFORMATION:

NAME

SAKAGUCHI, SHINJI

SESHIMOTO, OSAMU

TAKAYAMA, TAKESHI

SATO, AKIRA

COUNTRY

JP

JP

JP

JP

US-CL-CURRENT: 128/839

INT-CL (IPC): G01N 27/30

EUR-CL (EPC): G01N027/333

Full	Title	Citation	Front	Review	Classification	Date	Reference	Sequences	Attachments
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KWIC	Draw Desc	Image
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☐ 4. Document ID: JP 11015099 A

L12: Entry 4 of 9

File: DWPI

Jan 22, 1999

DERWENT-ACC-NO: 1999-157829

DERWENT-WEEK: 199919

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TITLE: Silver halide photosensitive material - containing a benzimidazole-carbocyclic aniline colourant, a pyrazole compound and a polymer latex with an active methylene group

PRIORITY-DATA: 1997JP-0184387 (June 25, 1997)

PATENT-FAMILY:

PUB-NO

PUB-DATE

LANGUAGE

PAGES

MAIN-IPC

JP 11015099 A

January 22, 1999

057

G03C001/18

INT-CL (IPC): G03 C 1/00; G03 C 1/035; G03 C 1/04; G03 C 1/09; G03 C 1/16; G03 C 1/18; G03 C 1/34; G03 C 1/95

Full	Title	Citation	Front	Review	Classification	Date	Reference	Sequences	Attachments
Image									

KWIC	Draw Desc	Clip Img
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☐ 5. Document ID: JP 08137060 A

L12: Entry 5 of 9

File: DWPI

May 31, 1996

DERWENT-ACC-NO: 1996-312995

DERWENT-WEEK: 199632

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TITLE: Developing process giving high contrast images - for silver halide photographic material contg. polymer latex in emulsion or hydrophilic colloid layer

PRIORITY-DATA: 1994JP-0293681 (November 4, 1994)

PATENT-FAMILY:

PUB-NO

PUB-DATE

LANGUAGE

PAGES

MAIN-IPC

JP 08137060 A

May 31, 1996

035

G03C005/29

INT-CL (IPC): G03 C 1/04; G03 C 1/047; G03 C 1/06; G03 C 1/85; G03 C 1/91; G03 C 5/29

Full	Title	Citation	Front	Review	Classification	Date	Reference	Sequences	Attachments
Image									

KWIC	Draw Desc	Clip Img
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6. Document ID: JP 39523 A

L12: Entry 6 of 9

File: DWPI

Sep 12, 1995

DERWENT-ACC-NO: 1995-349275

DERWENT-WEEK: 199545

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TITLE: Silver halide photographic material - is sensitised by methine dye and contains hydrazine deriv. and polymer latex to reduce black pepping

PRIORITY-DATA: 1994JP-0030205 (February 28, 1994)

PATENT-FAMILY:

PUB-NO	PUB-DATE	LANGUAGE	PAGES	MAIN-IPC
JP 07239523 A	September 12, 1995		048	G03C001/04

INT-CL (IPC): G03 C 1/035; G03 C 1/04; G03 C 1/053; G03 C 1/06; G03 C 1/18; G03 C 5/30; G03 C 5/38

Full	Title	Citation	Front	Review	Classification	Date	Reference	Sequences	Attachments
Image									

KWIC	Draw Desc	Clip Img
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7. Document ID: JP 05241305 A

L12: Entry 7 of 9

File: DWPI

Sep 21, 1993

DERWENT-ACC-NO: 1993-332191

DERWENT-WEEK: 199342

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TITLE: Photothermographic colour transfer material for image without colour stains - comprising hydrophilic binder, silver halide non-diffusible coupler forming diffusible dye and P-phenylene di:amine type colour developer

PRIORITY-DATA: 1992JP-0039674 (February 26, 1992)

PATENT-FAMILY:

PUB-NO	PUB-DATE	LANGUAGE	PAGES	MAIN-IPC
JP 05241305 A	September 21, 1993		046	G03C008/40

INT-CL (IPC): G03C 1/498; G03C 1/73; G03C 5/00; G03C 7/32; G03C 8/40

Full	Title	Citation	Front	Review	Classification	Date	Reference	Sequences	Attachments
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KWIC	Draw Desc	Image
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8. Document ID: JP 61236542 A

L12: Entry 8 of 9

File: DWPI

Oct 21, 1986

DERWENT-ACC-NO: 1986-316734

DERWENT-WEEK: 198648

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TITLE: Stable silver halide photographic material - has specific polymer latex in hydrophilic colloid layer

PRIORITY-DATA: 1985JP-0078904 (April 13, 1985)

PATENT-FAMILY:

PUB-NO	PUB-DATE	LANGUAGE	PAGES	MAIN-IPC
JP 61236542 A	October 21, 1986		012	

INT-CL (IPC): G03C 1/04

Full	Title	Citation	Front	Review	Classification	Date	Reference	Sequences	Attachments
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KWIC	Draw Desc	Image
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9. Document ID: DE 3222464 A GB 2105043 A GB 2105043 B GB 2146439 A GB 2146439 B JP 57206853 A JP 57211055 A JP 57211056 A

L12: Entry 9 of 9

File: DWPI

Dec 30, 1982

DERWENT-ACC-NO: 1983-02504K

DERWENT-WEEK: 198302

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TITLE: Halogen ion concn. measuring silver silver halide electrode - covered with halogen ion-permeable polymer latex, copolymer or polymer mixt.

INVENTOR: SAKAGUCHI, S; SATO, A ; SESHIMOTO, O ; TAKAYAMA, T

PRIORITY-DATA: 1981JP-0096882 (June 22, 1981), 1981JP-0092887 (June 15, 1981), 1981JP-0096881 (June 22, 1981)

PATENT-FAMILY:

PUB-NO	PUB-DATE	LANGUAGE	PAGES	MAIN-IPC
DE 3222464 A	December 30, 1982		073	
GB 2105043 A	March 16, 1983		000	
GB 2105043 B	May 14, 1986		000	
GB 2146439 A	April 17, 1985		000	
GB 2146439 B	May 14, 1986		000	
JP 57206853 A	December 18, 1982		000	
JP 57211055 A	December 24, 1982		000	
JP 57211056 A	December 24, 1982		000	

INT-CL (IPC): G01N 27/58

Full	Title	Citation	Front	Review	Classification	Date	Reference	Sequences	Attachments
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MMIC	Draw Desc	Image
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